

### **REMARKS/ARGUMENTS**

Claims 1, 4-9, 11-14, 16, 17, 19-21 and 25 are pending in this application. Claims 2-3, 10, 15, 18, 22-24 have been cancelled without prejudice. Claims 1, 4, 9, 11-14, 16-17 and 19 have been amended. Claim 1, 9 and 16 are independent claims. Support for the amendment may be found throughout the specification and drawings.

New claim 25 has been added to further define Applicants' invention. Support for Claim 25 is found on FIG. 3 and page 6, lines 22-29 through page 7, lines 1-9 of Applicants' specification. No new matter has been added.

#### **Specification**

The paragraphs [0010] and [0027] have been amended to correct minor editorial problems.

#### **Drawings objections**

FIG.1 has been object to because FIG. 1 included multiple items labeled as item 20. Amended FIG.1 has one item labeled 20 included. Amended FIG. 2 depicts a different embodiment of item 20.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because the item 10 in FIG. 1, item 80 in FIG. 2 and item 100 in FIG. 3 have not been mentioned in the description. In the specification, the paragraphs [0017] and [0019] have been amended to mention item 10 in FIG.1 and item 80 in FIG. 2. Item 100 in FIG. 3 has been removed.

Accordingly, removal of the drawing objections is respectfully requested.

#### **Claim objections**

Claim 2 was objected to under 37 CFR 1.75 (c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 2 has been cancelled without prejudice. Removal of the claim objection is respectfully requested.

**Drawings:**

The attached sheets of drawings, which include FIGS. 1-3, replace the original sheets including FIGS. 1-2.

Attachment:            Replacement Sheets

Double Patenting

The Patent Office directed Claims 1-22 of instant application to the same invention as that of claims 1-20 of commonly assigned U.S. Patent 6,732,201. Applicants respectfully traverse.

A good test, and probably the only objective test, for "same invention," is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention. *In re Vogel*, 422 F.2d 438, 164 USPQ 619, at 622 (C.C.P.A. 1970).

The Patent Office fails to show that the same invention has been claimed twice in U.S. Patent 6,732,201 and the instant application. The Patent Office asserted that "although the conflicting claims are not identical, they are *not patentably distinct* from each other because the difference between the patented claims and the presented claims consist only for the provision... The differences between the claimed inventions are minimal ...since sending a message via a frame has been widely implemented in the networking arts and was well known in the art at the time of the invention." (Office Action Page 4)

Applicants respectfully submit that the rejection made by the Patent Office lacks the necessary literal infringement analysis. Accordingly, under *Vogel*, the Patent Office does not establish a *prima facie* case of double patenting.

However, independent claims 1, 9, 16 have been amended to further define Applicants' invention over U.S. Patent 6,732,201. Withdrawal of the pending double patenting rejection is respectfully requested.

Claim Rejections- 35 U.S.C. § 102

The Patent Office rejected Claims 1-3, 9-12, 14, 16-24 under 35 U.S.C. § 102(b) as being anticipated by Fibre Channel Framing and Signaling working draft proposal, ("FC-FS Draft Standard," Rev. 1.30 published on July 9, 2001). Applicants respectfully traverse. However, claims 2, 3, 10, 18 and 22-24 have been cancelled.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220

USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, “anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

The Patent Office, while rejecting claims 1, 9 and 16, has particularly reviewed claim 1. Claim 1, along with claims 9 and 16, include elements that have not been taught, disclosed or suggested by FC-FS Draft Standard. For example, FC-FS Draft Standard fails to teach, disclose or suggest “sending the change speed frame from a bridge controller to the selected enclosure services module,” as recited in Claim 1.

The Patent Office asserted that “FC-FS Draft Standard discloses a multi-ported system with two links that allow speed negotiation between ports on a channel. The speed negotiation algorithm asks for a speed change and then alter the speed of the channel based upon the request,” citing pages 532-533 of FC-FS Draft Standard (Office Action Page 5). As indicated by the Patent Office, FC-FS Draft Standard teaches a speed negotiation algorithm between two ports. Particularly, the speed negotiation algorithm set forth by FC-FS Draft Standard is specified for only one port at a time and, further, implemented by one port to another port (Page 533 of FC-FS Draft Standard). Those of ordinary skill in the art would appreciate that such a speed negotiation algorithm implemented by one port to another port has an inherent problem of controlling.

In contrary, in the present invention, a bridge controller is responsible to implement a speed negotiation algorithm (by sending a speed frame) to enclosures on a redundant channel (a first channel). Consequently, the speed of the second channel is to be changed. An advantageous aspect of the present invention may be that the speed change can be done in a controlled manner since the bridge control provides a centralized implementation of sending speed frames.

However, the passages cited by the Examiner fail to teach “sending the change speed frame from a bridge controller to the selected enclosure services module,” (emphasis added), as recited in Claim 1. In fact, the same passages even fail to teach,

disclose or suggest a step involving a centralized implementation of the speed negotiation algorithm.

Accordingly, the rejection of Claim 1 should be withdrawn, and Claim 1 is allowable. Claims 9 and 16 are believed allowable for similar reasoning. Claims 11-12, 14, 17, 19, 20, and 21 are believed to be allowable based on their dependence upon allowable base claims.

Claim Rejections – 35 U.S.C. § 103

The Patent Office rejected Claims 4, 6-7 under 35 U.S.C. § 103(a) as being unpatentable over FC-FS Draft Standard. The Patent Office rejected Claim 5 under 35 U.S.C. § 103(a) as being unpatentable over FC-FS Draft Standard and Wall et al (“Wall”, U.S. Patent No. 6,507,923). Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over FC-FS Draft Standard and Mulvey et al. (“Mulvey”, U.S. Patent No. 6,629,219) Applicants respectfully traverse these rejections.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). See also *In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

Further, “to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

As indicated in the foregoing Claim Rejections – 35 USC § 102 section, the primary reference, FC-FS Draft Standard fails to disclose, teach or suggest all the elements recited in Claims 1, 9 and 16. Applicants respectfully submit that any of the ancillary references (Wall and Mulvey) does not make up for the defects of FC-FS Draft Standard.

Wall is cited for the disclosure of use of a third channel in the system which the Patent office admitted that FC-FS Draft Standard does not explicitly disclose. However, Wall does not cure the defect of FC-FS Draft Standard in reference to Claims 1, 9 and 16. Mulvey is cited for the disclosure of a by-pass selector section which can by-pass disk drives, which the Patent office admitted that FC-FS Draft Standard does not explicitly disclose. However, Mulvey does not cure the defect of FC-FS Draft Standard in reference to Claims 1, 9 and 16.

Thus, independent Claims 1, 9 and 16 are nonobvious under 35 U.S.C. § 103(a). Claims 4, 5, 6-7, and 13 are believed to be allowable based on their dependence upon allowable base claims. Removal of all the pending rejections under 35 U.S.C. §103 is respectfully requested.

**CONCLUSION**

In light of the forgoing amendments and arguments, reconsideration of the claims is hereby requested, and a Notice of Allowance is earnestly solicited.

Respectfully submitted,

LSI Logic Corporation,

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By: 

Sunah K. Lee  
Reg. No. 53,198

Sunah K. Lee  
SUITER – WEST PC LLO  
14301 FNB Parkway, Suite 220  
Omaha, NE 68154  
(402) 496-0300      telephone  
(402) 496-0333      facsimile

Attachments